

Remarks

Reconsideration of this Application is respectfully requested.

Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. The Finality of the Office Action Mailed January 14, 2003, is Improper

Applicant respectfully submits that the finality of the Office Action mailed January 14, 2003, is improper. "The claims of a new application may be finally rejected in the first Office Action in those situations where . . . (2) [the application] would have been properly finally rejected on the grounds and art of record in the next Office Action if they had been entered in the earlier application." M.P.E.P. 706.07(b). The Examiner raises a new ground of rejection under 35 U.S.C. § 102(g) wherein the Applicant is now required to state which entity is the prior inventor between the present application and U.S. Patent Nos. '717 and '347. (Paper No. 31, page 2). Because the outstanding Office Action raises a new § 102(g) issue, the rejection was improperly made final. Applicant requests that the finality of this rejection be withdrawn.

II. There is No Current Common Ownership Between the Present Application and the '717 and '347 Patents

The Examiner states on page 2, that “[c]laim [sic] 1-47 directed to the same invention as that of claim 5 of commonly assigned,” and “the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership” However, Applicant reiterates the fact that there is no common ownership.

The record shows that at the time of invention and filing of the present application, Eastman Chemical Company (“Eastman”) was the assignee, and the statement of common ownership on record in this case serves to establish common ownership between the present application and the '717 and '347 patents **at the time of invention and at the time of filing**. Archer-Daniels-Midland Company (“ADM”) subsequently acquired ownership of the application, wherein Eastman divested all its former ownership rights. An Assignment to ADM for Recordation was filed on February 11, 2000 covering U.S. rights to the present application. An Assignment to ADM for Recordation was filed on January 6, 2003 stating that ADM is the sole owner of the world-wide rights to the present application. Thus, the evidence on record shows that currently the present application is owned by ADM, whereas U.S. Patent Nos. '717 and '347 are owned by a completely separate entity, Eastman.

“As long as principal ownership rights to either the subject matter or the claimed invention reside in different persons or organizations common ownership does not exist.” M.P.E.P. 706.02(l)(2)I. Because ownership between the present application and the '717 and '347 patents resides in different persons or organizations, *i.e.* ADM vis-à-vis

Eastman, common ownership between the application and the patents does not exist.

Thus, it is established that the owner of the application and the owner of the patents in question are not a single party, but are different organizations such that common ownership between the application and the patents is impossible under the MPEP guideline.

III. The Present Claims are Not the Same as the Claims of the '717 and '347 Patents and, Thus, the § 1.132 Declaration is Relevant

With regard to the rejection of claims 1-47, under 35 U.S.C. § 102(f), the Examiner states, “the present subject matter has been in possession and enforcing identical scope, in claim 5 of US ‘717.” (Paper No. 31, pages 2-3). Applicant respectfully points to the fact that the instant claims are not identical to the subject matter described in claim 5 of the ‘717 patent. Claim 5 of the ‘717 patent depends from claim 1, which is directed to a method comprising step (d) wherein an extraction solvent is used to expressly solvate tocotrienols selectively over tocopherols. Claim 1 reads, “the selectivity of the extraction solvent for the tocotrienol with respect to the tocopherol is greater than unity.” According to the specification, the term “greater than unity” is defined as the ratio of extracted tocotrienols over extracted tocopherol. Thus, the solvent is utilized to solvate the tocotrienols in a first phase, thereby aiming to leave the tocopherols in a second phase. An extraction expressly to remove any tocopherol component from the material is not addressed in the ‘717 patent until claim 55, wherein the antecedent second phase of claim 1 is extracted to remove tocopherols. At this point, the second phase is the remaining phase after removal of the tocotrienols by the method

described in claim 1, step (d). The instant claims are directed to a method of extracting a tocopherol from a tocopherol containing admixture where, for example, there is no reference to the tocotrienol extraction step of the '717 patent. Thus, the processes of the '717 patent and the instant application are not identical in scope. Because the present claims are not the same as the claims in the '717 and '347 patents, the § 1.132 declaration applies. Applicant respectfully requests that the § 1.132 declaration be entered and the § 102(f) rejection withdrawn.

IV. An Obvious-Type Double Patenting Rejection is Improper

The Examiner has maintained the double patenting rejection of claims 1-47, citing the reasons set forth in Paper No. 25. "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." MPEP 707.07(f). Applicant respectfully points out that in Paper No. 25, the previous Examiner did not address the arguments which were presented in support of Applicant's position that an obviousness-type double patenting rejection is improper, such as the applicability of 35 U.S.C. 103 (c) under the present circumstances. Therefore, Applicant respectfully requests that the Examiner consider our argument and withdraw this rejection, or specifically address our points, and state the reasons for the obviousness-type double patenting rejection in view of our argument.

Because the present application falls within the provisions of 35 U.S.C. § 103(c), the judicial doctrine of obviousness-type double patenting as applied prior to enactment

of 35 U.S.C. § 103(c) is no longer applicable in this situation. Section 35 U.S.C.

§ 103(c) is plain and unequivocal in setting forth that the earlier inventions (*i.e.*, US-'347 and US-'717) are disqualified as prior art against the later invention.

The statute reads as follows:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Regarding the applicability of 35 U.S.C. § 103(c), the MPEP states that:

Two inventions of different inventive entities come within the provisions of 35 U.S.C. 103(c) when:

(A) the later invention is not anticipated by the earlier invention under 35 U.S.C. 102;

(B) the earlier invention qualifies as prior art for the purposes of obviousness under 35 U.S.C. 103 against the later invention only under subsection (f) or (g) of 35 U.S.C. 102, or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999; and

(C) the inventions were, at the time the latter invention was made, owned by the same person or subject to an obligation of assignment to the same person.

MPEP § 804.03 II.

Further, regarding the establishment of a basis for obviousness-type double patenting, the MPEP states:

[A]ny analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination.

MPEP § 804 II B (1).

The MPEP makes it clear that an obviousness-type double patenting rejection relies on claimed subject matter in a prior art reference that renders a present claim

obvious. The previous Examiner revealed that he utilized 35 U.S.C. § 103 guidelines in his analysis and rejection by asserting that the claimed invention of the present application would have been obvious to one of ordinary skill in the art at the time of invention in view of the claimed inventions of US-'347 and US-'717. However, when 35 U.S.C. § 103(c) is properly applied in this situation, US-'347 and US-'717 are statutorily barred from use against the present application. Thus, there is no longer support for the obviousness-type double patenting rejection.

Applicant respectfully requests that this rejection be withdrawn. If the Examiner maintains this rejection, Applicant requests that the Examiner address the issues and state the reasons for maintaining the rejection.

V. An Interference Proceeding Should be Instituted

In the outstanding Office Action at page 3, the Examiner maintains the double patenting rejection for the reasons set forth in Paper No. 25. In Paper No. 25, page 3, lines 7-8, the Examiner states that, "although the conflicting claims are **not** identical, they are not patentably distinct from each other" (Emphasis added.) Applicant respectfully asserts that maintaining this reasoning as a ground for rejection verifies that an Interference proceeding should be instituted because, a) the subject matter in question is allegedly not patentably distinct, and b) the record shows that the application has the same priority date and is assigned to a different entity. Therefore, an Interference proceeding should be declared.

Conclusion

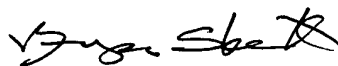
Applicant has addressed all outstanding issues. Applicant asserts that because the present subject matter is distinguishable from the '717 and '347 patents, the § 1.132 declaration is operable. Thus, the declaration establishes that Charles E. Sumner, Jr. is the sole inventor of the present subject matter and the § 102(f) rejection is rendered moot. If the Examiner maintains that the subject matter of the present application is not patentably distinct from the claims of the '717 and the '347 patents, Applicant requests that an Interference proceeding be declared.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Bryan L. Skelton
Agent for Applicant
Registration No. 50,893

Date: 7.4.03

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600